

Amendment in response to  
February 15, 2008 Office Action

Atty Dkt No.: 2003P04023US  
Serial No.: 10/625,960

### REMARKS

Claims 1 – 40 remain in the application and stand rejected. Claim 39 is amended herein. New claims 41 and 42 are added. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

The MPEP provides in pertinent part "the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application." MPEP 2164.04 (emphasis original).

Claim 39 is amended herein for clarity. No new matter is added.

New claims 41 and 42 are added herein to recite that the annotated message may be stored over the original. This is supported by claims 19 and 39 and by the specification at page 6, lines 7 – 10 ("When the caller completes rendering the message, the caller may be asked (preferably using IVR system) to decide if the annotated (edited) message is to be saved as a new message or to replace the original message."). No new matter is added. This is neither shown nor suggested by any reference of record. Independent consideration and allowance of claims 41 and 42 is respectfully requested.

Claims 1, 2, 5, 7 – 10, 12 – 19, 21, 22, 25, 27 – 30, and 32 – 39 are rejected under 35 U.S.C. §102(e) or 103(a) over published U.S. Patent application No. 2002/0129057 to Spielberg. Claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 are rejected under 35 U.S.C. §103(a) over Spielberg in combination with published European Patent

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Application No. EP-0-865-189-A2 to Pizano et al. The rejection is respectfully traversed.

Claim 1 recites a "method for **inserting** a caller's speech annotations **into** an original message," at line 1 (emphasis added). See *also*, claim 21, line 1. So the claims recite, not just providing annotations, but *inserting* those annotations *into* the original message. This is done by "annotating [a] speech message with at least one speech annotation; and **inserting** [that] speech annotation **into** said original message." Claim 1 lines 4 – 5 (emphasis added). See *also*, claim 21, lines 4 – 5.

Essentially, the Office action asserts that because Spielberg teaches "comment becomes **associated** with the location in the document where the comment was provided," (at paragraph 0018 (emphasis added)), Spielberg must be teaching the annotations into the original message. However, that is not what Spielberg teaches.

As the Office action notes, Spielberg teaches "apparatus and methods ... [that allow] users to review and **add** any number of annotations (i.e. **add** comments) to a digital document such as movie scripts, books, etc. from anywhere in the world." See, e.g., Abstract, paragraph 0018 and 0042. However, adding annotations as taught by Spielberg does not entail inserting them into the original. Instead,

Once the user provides comments 512, annotating engine 500 **associates** comment 512 with the location in the document where the comment was provided. For example, annotating engine 500 **preserves the original document in memory 504 and creates the associated files** (i.e., Annotations file, Annotations index file, and Annotations names file) as shown in FIG. 11.

Paragraph 0059 (emphasis added). Thus, Spielberg teaches generating additional files with the annotations for the original document; and so, fails to teach a "method for **inserting** a caller's speech annotations **into** an original message," by "**inserting** said speech annotation **into** said original message." *Supra*. Therefore, Spielberg fails to teach the present invention as recited in claims 1 and 21.

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Moreover, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."). Therefore, Spielberg fails to teach the present invention as recited by claims 2, 5, 7 – 10, 12 – 19, 22, 25, 27 – 30, and 32 – 39, which depend from claims 1 and 21. Reconsideration and withdrawal of the rejection of claims 1, 2, 5, 7 – 10, 12 – 19, 21, 22, 25, 27 – 30, and 32 – 39 under 35 U.S.C. §§102(e) and 103(a) is respectfully requested.

Furthermore, because Spielberg teaches augmenting the original file with associated annotation files (*supra*), all of those files must be forwarded for annotation by others or even, just for reviewing others' annotations. Losing a single one of these files, e.g., failing to send one, forgetting where it is stored or by one becoming corrupt, corrupts the annotation. Loss of the index file, for example, looses the linkage between the annotations and the original file. See, e.g., paragraph 0071. Thus, "forwarding said annotated message to another user," as recited by claims 20 and 40, is neither taught nor suggested by Spielberg, Pizano et al. or any other reference of record.

Nor, as previously noted, does Pizano et al. teach or suggest what is missing from Spielberg. Therefore, the combination of Pizano et al. with Spielberg fails to result in the present invention as recited in claims 1 and 21, from which claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 depend. Therefore, the combination of Pizano et al. with Spielberg does not make obvious the present invention as recited in claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40. Reconsideration and withdrawal of the rejection of claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 under 35 U.S.C. §103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner consider new claims 41 and 42, reconsider and

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withdraw the rejection of claims 1 – 40 under 35 U.S.C. §§102(b) and 103(a) and allow the application to issue.

As the Applicant has previously noted that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

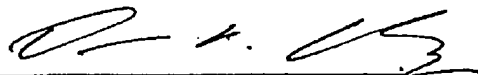
(emphasis added). The applicant believes that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Date:

14 May 08

Respectfully submitted,

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